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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,530	07/30/2003	Daniel R. Morris	037925.0003	9257

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01/05/2009

EXAMINER

MEYERS, MATTHEW S

ART UNIT	PAPER NUMBER
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3689

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/630,530

Applicant(s)

MORRIS, DANIEL R.

Examiner

MATTHEW S. MEYERS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's communication on 11/01/2007, wherein claims 1-25 are currently pending.

Priority

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted is being considered by the examiner.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible

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process under §101 and is non-statutory subject matter. With respect to claims 1-12, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by
Feinberg et al. (Pub. No.: US 2002/0107703) (Hereinafter referred to as Feinberg).

1. With respect to **Claim 1**:

Feinberg discloses a computer-based method for managing lien releases
(Feinberg [abs], “A method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset.”), comprising the steps of:

providing a lien release tracking component for tracking one or more liens
where a note underlying the one or more liens has been satisfied but the one or more liens have not been released (Feinberg [abs], “A method and system for

automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset.” and [0016], " Once the lien holder has been paid, a release or satisfaction is filed to indicate the debt has been paid.”);

providing a lien holder interface in communication with the lien release tracking component (Feinberg, Fig. 1);

receiving, by the lien holder interface from the lien release tracking component, a notice associated with at least one lien, said notice having lien transaction information and note identification information associated with the at least one lien (Feinberg [0016], “Once the lien holder has been paid, a release or satisfaction is filed to indicate the debt has been paid. The process for releasing the lien is similar to filing a lien. FIG. 3 shows the process steps of the release system. Viewed in conjunction with FIG. 1, in the preferred embodiment the client 10 transmits an e-mail message to the data processing server 30 via the Internet 20 giving notice that the client has received proper payment for a given patient's services.”).

generating a document associated with said notice. (Feinberg, [0017], “The document is updated with a recording number and a recording date. The liable party is served notice of the construction lien and the lien holder is notified of a perfected construction lien.”).

4. With respect to **Claim 2:**

Feinberg discloses wherein, upon said notice indicating that a note underlying said lien has a paid status but the lien has an unreleased status, said document generated is a release instrument (Feinberg [0016], "Once the lien holder has been paid, a release or satisfaction is filed to indicate the debt has been paid. The process for releasing the lien is similar to filing a lien. FIG. 3 shows the process steps of the release system. Viewed in conjunction with FIG. 1, in the preferred embodiment the client 10 transmits an e-mail message to the data processing server 30 via the Internet 20 giving notice that the client has received proper payment for a given patient's services.").

5. With respect to **Claim 3:**

Feinberg discloses wherein said notice is a demand letter issued from a settlement agent having access to said system (Feinberg [0016], "A release is prepared by the software program 50 from the patient and insurance data previously transmitted and stored in the database 40 when the lien was originally prepared. The release is prepared according to guidelines from each jurisdiction previously stored on the database 40. The release is transmitted in electronic form to the appropriate recording agency 60, unless the agency does not accept electronic filing. In such case, the release is printed on paper and manually delivered to the recording agency.").

6. With respect to **Claim 4:**

Feinberg discloses wherein said notice is an electronic communication (Feinberg [0012], "The data is transmitted using email communication protocols.").

7. With respect to **Claim 5:**

Feinberg discloses wherein said notice is a payoff disbursement package (Feinberg [0016], "Once the lien holder has been paid, a release or satisfaction is filed to indicate the debt has been paid.").

8. With respect to **Claim 6:**

Feinberg discloses wherein said document generated includes notice of receipt of said payoff package (Feinberg [0016], "Viewed in conjunction with FIG. 1, in the preferred embodiment the client transmits an e-mail message to the data processing server via the Internet giving notice that the client has received proper payment for a given patient's services.").

9. With respect to **Claim 7:**

Feinberg discloses wherein said notice is a payoff order (Feinberg [0016], "Viewed in conjunction with FIG. 1, in the preferred embodiment the client transmits an e-mail message to the data processing server via the Internet giving notice that the client has received proper payment for a given patient's services.").

10. With respect to **Claim 8:**

Feinberg discloses wherein said generated document is a payoff calculation statement (Feinberg [0015], "Reimbursements from the insurance company are used to satisfy the debt of the patient to the medical service provider.").

11. With respect to **Claim 9:**

Feinberg discloses the step of internally verifying a payoff (Feinberg Fig 3, Step 1, "Receive Notice of Client Payoff").

12. With respect to **Claim 10:**

Feinberg discloses wherein said notice is a closing communication (Feinberg Fig 3, Step 5, "Notify Patient That Lien has Been Released").

13. With respect to **Claim 11:**

Feinberg discloses wherein said document generated is one of a shortage report or a payment in full confirmation (Feinberg Fig 3, Step 5, "Notify Patient That Lien has Been Released").

14. With respect to **Claim 12:**

Feinberg discloses the step of establishing alert notices for at least one of a note cancellation, receipt of a payoff transmittal letter, receipt of a payoff check or wire (Feinberg [0004], "It is necessary to serve notice on the patient and all responsible insurance companies or parties that a lien on the expected payment has been recorded.")

15. With respect to **Claim 13:**

MERS discloses a computer-assisted system for responding to a notice that a lien is due for release, comprising:

a lien management component for receiving and storing lien identification information, including liens identifiable by lien holder (Feinberg, Figs. 1 and 3 and [0007], "The present invention provides a method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset.");

lien release tracking component in communication with the lien management component (Feinberg, Figs. 1 and 3 and [0007], “The present invention provides a method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset.”);

an interface for receiving, by the lien management component from the lien release tracking component, a notice associated with at least one lien held by lien holder, said notice including status information associated with said at least one lien pertaining to whether the lien is due or overdue for release by the lien holder, said status information including lien transaction information and information on a note underlying the lien (Feinberg, Figs. 1 and 3 and [0007], “The present invention provides a method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset.” and [0016] “Once the lien holder has been paid, a release or satisfaction is filed to indicate the debt has been paid; and

an interface for issuing, by the lien management component, a response to said notice (Feinberg [0016], “A release is prepared by the software program 50 from the patient and insurance data previously transmitted and stored in the database 40 when the lien was originally prepared. The release is prepared

according to guidelines from each jurisdiction previously stored on the database 40.”).

16. With respect to **Claim 14:**

Feinberg discloses means for at least one of confirming or disputing said status of said at least one lien (Feinberg [0016], “Once the lien holder has been paid, a release or satisfaction is filed to indicate the debt has been paid.”).

17. With respect to **Claim 15:**

Feinberg discloses wherein, upon said notice indicating that a note underlying said lien has a paid status but the lien has an unreleased status, said document generated is a release instrument (Feinberg [0016], “Once the lien holder has been paid, a release or satisfaction is filed to indicate the debt has been paid.”).

18. With respect to **Claim 16:**

Feinberg discloses wherein said notice is a demand letter issued from a settlement agent having access to said system (Feinberg [0012], “The guidelines set forth the content and format of the information required to properly file a lien in each given jurisdiction. The guidelines are compiled from statutes, regulations, and local practice for each locale.”).

19. With respect to **Claim 17:**

Feinberg discloses wherein said notice is an electronic communication (Feinberg [0012], “The data is transmitted using email communication protocols.”).

20. With respect to **Claim 18:**

Feinberg discloses wherein said notice is a payoff disbursement package (Feinberg [0016], "Once the lien holder has been paid, a release or satisfaction is filed to indicate the debt has been paid.").

21. With respect to **Claim 19:**

Feinberg discloses wherein said document generated includes notice of receipt of said payoff package (Feinberg [0016], "Viewed in conjunction with FIG. 1, in the preferred embodiment the client transmits an e-mail message to the data processing server via the Internet giving notice that the client has received proper payment for a given patient's services.").

22. With respect to **Claim 20:**

Feinberg discloses wherein said generated document is a payoff calculation statement (Feinberg [0015], "Reimbursements from the insurance company are used to satisfy the debt of the patient to the medical service provider.").

23. With respect to **Claim 21:**

Feinberg discloses the step of internally verifying a payoff (Feinberg Fig 3, Step 1, "Receive Notice of Client Payoff").

24. With respect to **Claim 22:**

Feinberg discloses wherein said notice is a closing communication (Feinberg Fig 3, Step 5, "Notify Patient That Lien has Been Released").

25. With respect to **Claim 23:**

Feinberg discloses wherein said notice is a payoff order (Feinberg [0016], "Viewed in conjunction with FIG. 1, in the preferred embodiment the client transmits an

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e-mail message to the data processing server via the Internet giving notice that the client has received proper payment for a given patient's services.”).

26. With respect to **Claim 24**:

Feinberg discloses wherein said document generated is one of a shortage report or a payment in full confirmation (Feinberg Fig 3, Step 5, “Notify Patient That Lien has Been Released”).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feinberg.

27. With respect to **Claim 25**:

Feinberg discloses a computer-based method for generating a lien release (Feinberg [abs], "A method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset."), comprising the steps of:

receiving by a lien management interface, a payoff order for a loan from a computer-based release tracking component, said tracking component issuing the payoff order for the loan based on a calculated trigger date indicative of when the lien is required to be released, (Feinberg Fig.3, and [0016], "A release is prepared by the software program 50 from the patient and insurance data previously transmitted and stored in the database 40 when the lien was originally prepared. The release is prepared according to guidelines from each jurisdiction previously stored on the database 40." and [0013], "The recording agency 60 reviews the document for proper format and content. If acceptable, the recording agency records the medical lien, giving it a recording number and a recording date." and Claim 7) (Examiner is interpreting the trigger date as defined in applicant's specification at page 27, "The trigger date calculation can be jurisdiction-specific. For example, some jurisdictions may calculate deadlines for payoff lender releases of liens based on the date of settlement, others based on payoff date, and so forth. In another embodiment, the trigger date can be calculated based on an overdue release date. Statutory 25 requirements can be stored in a database accessible to the settlement agent and other entities

identified above via network connection, for example, and such statutory requirements can be updated on an individual jurisdictional basis.”)

validating, by the lien management interface, said loan information and verifying title information on a lien associated with said loan (Feinberg [0012], “The guidelines set forth the content and format of the information required to properly file a lien in each given jurisdiction. The guidelines are compiled from statutes, regulations, and local practice for each locale. If comparison shows that the data fits the appropriate guidelines, the server 30 returns an acknowledgment to the client 10 via the Internet 20.”);

presenting payoff information to the lien management interface (Feinberg Fig.3, Step 5, “Notify Patient That Lien Has Been Released.”);

receiving, by the lien management interface, a payoff amount and payoff disbursement package (Feinberg [0015], “Patient and insurance data is received from a remote node and stored in the database.”);

reporting receipt of the payoff disbursement package to the lien management interface (Feinberg [0016], “Once the lien holder has been paid, a release or satisfaction is filed to indicate the debt has been paid.”);

verifying, by the lien management interface, the payoff amount (Feinberg [0016], “Viewed in conjunction with FIG. 1, in the preferred embodiment the client 10 transmits an e-mail message to the data processing server 30 via the Internet 20 giving notice that the client has received proper payment for a given patient's services.”); and

generating, by the lien management interface, a lien release (Feinberg [0016], "Once the lien holder has been paid, a release or satisfaction is filed to indicate the debt has been paid.")

Feinberg discloses all the above limitations. Feinberg additionally discloses that said loan is identified by a recording number and a recording date [Feinberg [0013]. Feinberg does not explicitly wherein said loan being identified by at least one of loan identification number, obligor or property description. It would have been obvious to one of ordinary skill in the art at the time of the invention to have identified the loan using any information normally used in that field. For example, a car loan may be identified by a vehicle identification number (VIN) which would only be available for cars. Therefore it would have been obvious to have substituted any acceptable means for identification instead of loan identification number, obligor or property description, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Response to Arguments

1. Applicant's arguments filed 11/01/2007 have been fully considered but they are not persuasive regarding claims 1-24.
2. With respect to applicant's arguments regarding claim 1, Examiner respectfully disagrees. Although applicant argues that Feinberg deals with post-payment release recordation, applicant has not distinguished this with the claims. Although claims are

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interpreted in light of the specification, limitations from the specification are not read into the claims and Feinberg discloses the claimed limitations.

28. With respect to applicant's arguments regarding claim 13, Examiner respectfully disagrees. Examiner has responded to this argument above with pertinent citations from Feinberg. However, again, Examiner respectfully submits that applicant is arguing unclaimed limitations such as a receipt. Applicant's specification is not a substitute for, nor can it be used to rewrite, the chosen claim language. In re Van Geuns, 26 USPQ2d 1057 (CA FC 1993).

3. With respect to claim 25, applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW S. MEYERS whose telephone number is (571)272-7943. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S Meyers/
Examiner, Art Unit 3689

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689